



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,112	08/21/2006	Akira Uematsu	8006-1032	7421
<small>465</small> YOUNG & THOMPSON 209 Madison Street Suite 500 ALEXANDRIA, VA 22314			<small>7590</small> EXAMINER WOO, KUO-KONG	
			<small>07/23/2009</small> ART UNIT 2617	PAPER NUMBER
			MAIL DATE 07/23/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/576,112

Applicant(s)

UEMATSU ET AL.

Examiner

KUO WOO

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-55 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 21 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-85/86)
Paper No(s)/Mail Date 4/14/06 and 12/31/08
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Inventor's Patent Application
6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) filed on 4/16/2006 and 12/31/2008 has been considered.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

3. The drawings submitted on 8/21/2006. These drawings are reviewed and accepted by the examiner.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter. Functional Descriptive Material (programs and Data structures).

5. Claims 50-55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 50-55 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1 (a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Claims 50-55, while defining a program causes in a positional information notification system does not define a "computer-readable medium" and is thus non-statutory for that reasons. A computer program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" in order to make the claim statutory.

"In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." - MPEP 2106.IV.B.1 (a)

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. Undue multiplicity exists because all independent claims have been repeated without distinctly claiming the subject matter. See MPEP:

2173.05(n) [R-2] Multiplicity

37 CFR 1.75. Claim(s).

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.

7. Claims 1,4,7,10, 17-31,34-35,40,43,45,50-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 50, a positional information notification system comprising (a mobile communication network), (one or two terminal position determination devices), (one or more servers), (terminal) ...are repeated throughout all independent claim. Where, in view of the nature and scope of applicant's invention, applicant presents an unreasonable number of claims which most of contents are repetitious and multiplied, the net result of which is to confuse rather than to clarify, a rejection on undue multiplicity based on 35 U.S.C. 112, second paragraph. As noted by the court in *In re Chandler*, 319 F.2d 211, 225, 138 USPQ 138, 148 (CCPA 1963), "applicants should be allowed reasonable latitude in stating their claims in regard to number and phraseology employed.

All remaining independent claims are rejected as same reasons as claims 1 and 50 which have been repeated each content throughout entire claims and fail to point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-30 and 40-49 are rejected under 35 U.S.C. 102 (e) as being anticipated by Evensen et al. (US-PGPUB 2003/0153332 A1).

Regarding claim 1, Evensen discloses "A positional information notification system comprising a mobile communication network (Abstract, A **system and method** in a **mobile communication network** for providing **enhanced user privacy** when responding to a **location request** from a **client requesting location information** for a **mobile terminal**). to which one or more terminals and one or more terminal position determination devices are connected, and one or more servers (Abstract, a home location register/home **subscriber server (HLR/HSS)** associated with the **mobile terminal**) that can communicate with said terminal, said terminal position determination device (§105, The main network component for providing LCS services is the GMLC

(**Gateway Mobile Location Center**) (Terminal Position Determination Device), to which all location requests are transmitted, and which, in return, provides the **requested location** from the mobile network,... tracking of **persons or vehicles**) having a function for receiving a position request message from said terminal and providing to said terminal, information on the position of said terminal, when said terminal notifies the server selected from said one or more servers that can communicate with said terminal of the positional information of the terminal itself, said terminal obtaining via said position request message said information on the position of the terminal itself from said terminal position determination device, determining the positional information of the terminal itself and notifying said selected server (¶16, The system includes a mobile location node that receives the location request from the client, **requests routing information from the HLR/HSS**, and forwards the location request to the service node; and a list stored in the HLR/HSS of **approved codewords associated with the mobile terminal**) of the positional information, wherein said terminal position determination device has privacy settings (¶15, The functionality of existing nodes such as the GMLC, HLR/HSS, SGSN, and MSC is extended, to provide **enhanced user privacy**) for users who use each of the terminals, and a privacy check unit, which privacy check unit having a function for determining, based on said privacy setting, whether to permit the notification of the positional information from said terminal to said selected server, wherein said terminal position determination device, upon receiving said position request message from said terminal, determines by using said privacy check unit whether to permit the notification (¶22, enhanced privacy checks and

can exercise full control in order to protect the privacy of subscribers roaming in a different PLMN) of the positional information from said terminal to said selected server, and if permitted, provides to said terminal said information on the position (§23, "Allowed Requestor List" or "codeword" to authorize LCS requests.) of said terminal". Wherein privacy setting is stored and compared to user profile for permit or reject to send location information to server (HSS).

Regarding claim 2, Evensen discloses "wherein said terminal position determination device inquires, (§06, The Provide Subscribe Location message is utilized by the GMLC to request the subscriber's location, from the Serving GPRS Support Node (SGSN) or Mobile Switching Center (MSC)) by using said privacy check unit (§06, The SGSN or MSC maps the received LCS client ID parameter to the **subscriber's recorded privacy parameters** (e.g., list of allowed LCS clients) to screen out any unwelcome location requests), of the user of said terminal about whether to permit the notification of the positional information to said selected server, and provides to said terminal said information on the position of said terminal (§16, providing enhanced user privacy when responding to a location request from a client requesting location information for a mobile terminal only when said user permits the notification of the positional information to said selected server" (§16, The mobile network includes a service node serving the mobile terminal and a home location register/home subscriber server (HLR/HSS) associated with the mobile terminal, wherein mobile unit will send location information to server (HSS) only if user permits.

Regarding claim 3, Evensen discloses "wherein a condition for said inquiry of the user of said terminal in said privacy check unit is that the notification of the positional information from said terminal to said selected server is not permitted based on the privacy setting for the user who uses said terminal". (¶27, If either one of the SGSN or MSC node supports the enhanced user privacy; **the HLR/HSS sends only** the routing address 15 of the node that supports the enhanced user privacy to the GMLC), and (¶35, the HLR/HSS (server) then verifies that the codeword received from the GMLC 5 matches one of the codewords 8 stored for the target subscriber. If the codeword does not match, the HLR/HSS may send an error indication to the GMLC, and the LCS procedure is ended. If the codeword matches, the HLR/HSS may verify that the VMSC supports the enhanced user privacy mechanisms (this information is received in the HLR/HSS at location update in the "LCS supported capabilities set"). In order to protect the privacy of a roaming subscriber, the HLR/HSS may reject the Send_Routing_Info_for_LCS message if the VMSC/SGSN does not support enhanced privacy checks. If the codeword matches, and the VMSC/SGSN supports the needed LCS capabilities, the HLR/HSS then sends the routing information (i.e., the VMSC/SGSN address) to the GMLC in a Send_Routing_Info_for_LCS_ack message 33),Wherein LC will send only if SGSN or MSC is supporting privacy setting.

Regarding claims 4, 5 and 6 have limitations similar to those treated in the above claim 1 rejection(s), and are met by the references as discussed above.

Regarding claim 7, Evensen discloses "two or more mobile communication networks (¶15, although the invention is described for exemplary purposes in the

context of GPRS/GSM, the invention may also be practiced in other **similar packet-switched or circuit-switched mobile telephone networks**) to which one or more terminals and one or more terminal position determination devices are connected, and one or more servers that can communicate with said terminal, said terminal position determination device having a function for receiving a position request message from said terminal and providing to said terminal, information on the position of said terminal, when said terminal notifies the server selected from said one or more servers that can communicate with said terminal of the positional information of the terminal itself, said terminal obtaining via said position request message said information on the position of the terminal itself from said terminal position determination device, determining said positional information of the terminal itself and notifying said selected server of said positional information,

wherein a first of said terminal position determination device associated with a first of said mobile communication network has privacy settings for users who use each of the terminals associated with said first mobile communication network, and a privacy check unit, which privacy check unit having a function for determining whether to permit, based on said privacy setting, the notification of the positional information from said terminal associated with said first mobile communication network to said selected server

(Abstract, A system and method in a mobile communication network for providing enhanced user privacy when responding to a location request from a client requesting location information for a mobile terminal. The system includes a mobile location node, a service node serving the mobile terminal, and a home location register/home

subscriber server (HLR/HSS) associated with the mobile terminal. A list of approved codewords and a list of approved service types are stored in the HLR/HSS, and only location requests that include approved codewords or service types from these lists are accepted by the system),

Wherein a second of said terminal position determination device associated with a second of said mobile communication network,(¶06, The SGSN or MSC maps the received LCS client ID parameter to the subscriber's recorded privacy parameters (e.g., list of allowed LCS clients) to screen out any unwelcome location requests) upon receiving said position request message from said terminal associated with the first mobile communication network, inquires of said first terminal position determination device about whether to permit the notification of the positional information from said terminal to said selected server,(¶07, It would also be desirable for the location information to be given only to those requestors who are entitled to have it).

wherein said first terminal position determination device determines by using said privacy check unit whether to permit, based on said privacy setting, the notification of the positional information from said terminal to said selected server, and notifies said second terminal position determination device of the result of the determination (¶12, Enhanced privacy handled in a GMLC located in the subscriber's home Public Land Mobile Network (HPLMN) that is connected to a GMLC in a Visited PLMN (VPLMN), wherein second terminal position determination device is located as Visited PLMN.

wherein said second terminal determination device provides to said terminal said information on the position of said terminal, if the notification of the positional

information (¶22, When a subscriber roams to a VPLMN, the HPLMN is made aware of the LCS capabilities of the VMSC/SGSN by means of a "Supported LCS capabilities sets" mechanism. Thus, the HPLMN (HLR/HSS) is aware of the VMSC/SGSN capability to support enhanced privacy checks and can exercise full control in order to protect the privacy of subscribers roaming in a different PLMN).from said terminal to said selected server is permitted based on the result of said determination notified from said first terminal position determination device". Wherein second terminal position device notifies server if is permitted by first terminal position device associated with enhance privacy check.

Regarding claims 8-14 have limitations similar to those treated in the above claim 7 rejection(s), and are met by the references as discussed above.

Regarding claim 15, Evensen discloses "wherein said information on the position provided to said terminal from said terminal position determination device is the positional information of said terminal" (¶39, if the service type supplied by the GMLC matches the identity of any service type contained in the UE's SLPP), wherein UE is user equipment as said terminal.

Regarding claim 16, Evensen discloses "wherein said information on the position provided to said terminal from said terminal position determination device is supplementary information (¶28,the GMLC 5 then forwards the LCS Request at 16 to the SGSN or MSC 3. The **forwarded LCS Request** carries the **Service Type (Service type and Requestor ID are supplementary information of UE location)** when one

has been received from the LCS Client 1. FIGS. 3A and 3B) required for said terminal to determine the positional information of the terminal itself”.

Regarding claim 17, Evensen discloses “a positional information notification method comprising the steps: (1) a terminal for notifying a server that can communicate with the terminal of the positional information of the terminal itself transmits a position request message (¶16, The system includes a mobile location node that receives the location request from the client, requests routing information from the HLR/HSS (server), and forwards the location request to the service node) to a terminal position determination device (¶05, The main network component for providing LCS services is the GMLC (Gateway Mobile Location Center), to which all location requests are transmitted, and which, in return, provides the requested location from the mobile network, wherein GMLC is terminal position determination device,

2) Terminal position determination device determines whether to permit the notification of the positional information (¶17, the main network component for providing LCS services is the GMLC (Gateway Mobile Location Center), to which all location requests are transmitted, and which, in return, provides the requested location from the mobile network) from said terminal to said server based on privacy setting information for a user who uses said terminal,

(3) if the notification of the positional information from said terminal to said server has been determined to be permitted, position measurement (¶17, the method may also include the steps of mapping the service identity received in the location request to a service type utilizing a mapping function in the mobile location node) is performed

between said terminal position determination device and said terminal, wherein mapping function is same as position measuring function of terminal location.

(4) Terminal position determination device (¶26, the GMLC may utilize mapping function 13 to map the received service identity to a corresponding service type. If the codeword functionality is supported, the GMLC may reject the LCS Request whenever the LCS Client type is "value added" and the codeword was not received) provides to said terminal the positional information of said terminal obtained by said position measurement,

(5) Terminal notifies said server of said provided positional information of the terminal itself. (¶24, It is understood that both the SGSN and the MSC inform the HLR of their current LCS capabilities during a previous Update Location procedure.)

Regarding claims 18-29 have limitations similar to those treated in the above claim 17 rejection(s), and are met by the references as discussed above.

Regarding claim 30 has limitations similar to those treated in the above claim 7 rejection(s), and are met by the references as discussed above.

Regarding claim 40, Evensen discloses "A privacy check device in a positional information notification system comprising a mobile communication network to which one or more terminals, one or more terminal position determination devices and one or more privacy check devices are connected, and one or more servers that can communicate with said terminal, said terminal position determination device having a function for receiving a position request message from said terminal and providing to said terminal, information on the position of said terminal, when said terminal notifies

the server selected from said one or more servers that can communicate with the terminal of the positional information of the terminal itself, (¶16, providing enhanced user privacy when responding to a location request from a client requesting location information for a mobile terminal. The mobile network includes a service node serving the mobile terminal and a home location register/home subscriber server (HLR/HSS) associated with the mobile terminal. The location request includes an identifier for the requesting client, a codeword, and a service identity. The system includes a mobile location node that receives the location request from the client, requests routing information from the HLR/HSS, and forwards the location request to the service node; and a list stored in the HLR/HSS of approved codewords associated with the mobile terminal. The codeword included in the location request must match a codeword from the codeword list for the location request to be accepted. The mobile location node then sends a mapped service type to the HLR/HSS when requesting routing information. The HLR/HSS includes a list of approved service types associated with the mobile terminal, and the mapped service type must match a service type from the service type list in the HLR/HSS for the location request to be accepted) said terminal obtaining via said position request message said information on the position of the terminal itself from said terminal position determination device, determining the positional information of the terminal itself and notifying said selected server of the positional information,

Wherein said privacy check device comprises a holding unit for holding privacy settings for users who use each of the terminals, and a privacy check unit for determining (¶21, privacy check is a comparison between information characterizing the

LCS request and information related to the subscriber profile) whether to permit, based on said privacy setting, the notification of the positional information from said terminal to said server,

wherein, when said terminal position determination device receives the position request message from said terminal, and inquires of said privacy check device about whether to permit the notification of the positional information from said terminal to said selected server, said privacy check device determines (§24, inform the HLR about their supported enhanced privacy capabilities 7. The HLR can use this information later when a positioning is to be performed for a subscriber handled by this SGSN or MSC. According to the present invention, the HLR's capabilities are further extended by adding a list of codewords 8 and a list of service types for each registered UE) by using said privacy check unit whether to permit, based on said privacy setting, the notification of the positional information from said terminal to said selected server, and notifies said terminal position determination device of the result of the determination".

Regarding claims 41-48 have limitations similar to those treated in the above claim 40 rejection(s), and are met by the references as discussed above.

Regarding claim 49, Evensen discloses "wherein said information on the position provided to said terminal from said terminal position determination device is supplementary information (§28, the GMLC 5 then forwards the LCS Request at 16 to the SGSN or MSC 3. The **forwarded LCS Request** carries the **Service Type (Service type and Requestor ID are supplementary information of UE location)** required for said terminal to determine the positional information of the terminal itself.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 31-39 and 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evensen et al. in view of Ichimura (US-PGPUB 2003/0084119 A1).

Regarding claim 31, Evensen discloses " A terminal position determination device in a positional information notification system comprising a mobile communication network to which one or more terminals and one or more terminal position determination devices are connected, and one or more servers (¶16, The mobile network includes a service node serving the mobile terminal and a home location register/home **subscriber server (HLR/HSS)** associated with the mobile terminal)that an communicate with said terminal, said terminal position determination device having a function for receiving a position request message from said terminal and providing to said terminal, information on the position of said terminal, when said terminal notifies the server selected from said one or more servers that can communicate with said terminal of the positional information of said terminal, said terminal obtaining via said position request message said information (¶105, The main network component for providing LCS services is the GMLC (Gateway Mobile Location Center), to which all location requests are transmitted, and which, in return, provides the requested location

from the mobile network.) on the position of the terminal itself from said terminal position determination device, determining the positional information of the terminal itself and notifying said selected server of the positional information,

wherein said terminal position determination device comprises a holding unit for holding a privacy setting (¶12, **Enhanced privacy** handled in a **GMLC** located in the subscriber's home Public Land Mobile Network (HPLMN) that is connected to a GMLC in a Visited PLMN (VPLMN)) for a user who uses said terminal, a privacy check unit for determining whether to permit, based on said privacy setting, the notification of the positional information from said terminal to said selected server, and a providing unit for, upon receiving said position request message from said terminal, determining by using said privacy check unit whether to permit the notification of the positional information from said terminal to said selected server, and, if permitted, providing to said terminal (¶15, The functionality of existing nodes such as the GMLC, HLR/HSS, SGSN, and MSC is extended, and a few changes in signaling are implemented, to provide enhanced user privacy) information on the position of said terminal"

Regarding claim 32, Evensen discloses "wherein the user of said terminal is inquired by said privacy check unit about whether to permit the notification of the positional information. However, Evensen does not explicitly disclose "said selected server", and said information on the position of said terminal is provided to terminal only when said user permits the notification of the positional information to said selected server".

In an analogous art, Ichimura discloses (Abstract, the position information processing terminal obtains a position of a user and when a current position of the user is inside of a predetermined region set in advance, refrains from transmitting position information **to a server** to make no request for position related information, thereby protecting privacy. In addition, switching position information of the user between transmission enabled and disabled every time the user comes in and out of a certain region realizes control of transmission/non-transmission of position information every time the user passes through a **specific region**), wherein information will send to specific server if get permit from the user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Evensen teaching in privacy setting in location notification of terminal device and in combination of Ichimura provides a position of a user to be transmitted to a server through a communication network to supply position related information which is related to the position information in question from the server) see (¶02).

Rationales for arriving at a conclusion of obviousness suggested by the Supreme Court's decision in KSR include:

Combine prior art elements according to known method to yield predictable result.

Regarding claims 33-37, Ichimura discloses "wherein a condition for said inquiry of the user of said terminal in said privacy check unit is that the notification of the positional information from said terminal to said selected server is not permitted based on the privacy setting (¶77, setting unit 40 is a means by which a user is allowed to set

a certain geographical region. By using the region setting unit 40, the user sets a geographical region where he/she wants to protect his/her **privacy** by **refraining from sending his/her own position information** to the position related information supply server)for the user who uses said terminal".

Regarding claim 38 has limitations similar to those treated in the above claim 32 rejection(s), and are met by the references as discussed above.

Regarding claim 39, Evensen discloses "wherein said information on the position provided to said terminal is supplementary information (§128, the GMLC 5 then forwards the LCS Request at 16 to the SGSN or MSC 3. The **forwarded LCS Request** carries the **Service Type (Service type and Requestor ID are supplementary information of UE location)** required for said terminal to determine the positional information of the terminal itself".

Regarding claim 50, Ichimura discloses" A program causes (§113, an object of the present invention is to provide a position information processing terminal and a position information supply system, and a position information processing method which intend to protect privacy of a user who is provided with position related information, and an operation **control program therefor**) in a positional information notification system comprising a mobile communication network to which one or more terminals and one or more terminal position determination devices are connected, and one or more servers that can communicate with said terminal, said terminal position determination device having a function for receiving a position request message from said terminal and providing to said terminal, information on the position of said terminal, when said

terminal notifies the server selected from said one or more servers that can communicate with said terminal of the positional information of said terminal, said terminal obtaining via said position request message said information on the position of the terminal itself from said terminal position determination device, determining the positional information of the terminal itself, and notifying said selected server of said positional information, a computer constituting (¶29, a **program for making a computer to execute a position information processing** method in a position information processing terminal for transmitting position information indicative of a position of a user to a server through a communication network and receiving position related information which is related to the position information from the server, comprising the function of) said terminal position determination device to function as a holding unit for holding the privacy setting for a user who uses said terminal, a privacy check unit for determining whether to permit, based on said privacy setting, the notification of the positional information from said terminal to said selected server, and a providing unit for, upon receiving said position request message from said terminal, determining by using said privacy check unit whether to permit the notification of the positional information from said terminal to said selected server, and, if permitted, providing to said terminal said information on the position of said terminal". Evensen discloses (¶06, The Provide Subscribe Location message is utilized by the GMLC to request the subscriber's location, from the Serving GPRS Support Node (SGSN) or Mobile Switching Center (MSC)) by using said privacy check unit (¶06, The SGSN or MSC maps the received LCS client ID parameter to the **subscriber's recorded privacy**

parameters (e.g., list of allowed LCS clients) to screen out any unwelcome location requests), of the user of said terminal about whether to permit the notification of the positional information to said selected server, and provides to said terminal said information on the position of said terminal (¶16, providing enhanced user privacy when responding to a location request from a client requesting location information for a mobile terminal only when said user permits the notification of the positional information to said selected server”(¶16, The mobile network includes a service node serving the mobile terminal and a home location register/home subscriber server (HLR/HSS) associated with the mobile terminal, wherein mobile unit will send location information to server (HSS) only if user permits.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Evensen teaching in privacy setting in location notification of terminal device and in combination of Ichimura provides computer program to execute the process through a communication network to supply position related information which is related to the position information in question from the server) see (¶29).

Rationales for arriving at a conclusion of obviousness suggested by the Supreme Court's decision in KSR include: Known work in one field of endeavor may prompt variation of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art; The TSM test.

Regarding claim 51-55 have limitations similar to those treated in the above claim 50 rejection(s), and are met by the references as discussed above.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- USPAT 7,269,428 B1 to Wallenius et al in method for enabling a user to be notified of his/he positioning requests discloses similar invention as claim 1.
- US-PGPUB 2005/0032529 A1 to Akama in positioning information providing method and positional information providing system discloses similar invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KUO WOO whose telephone number is (571)270-7266. The examiner can normally be reached on 10-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KUO WOO/
Examiner, Art Unit 2617

/Lester Kincaid/
Supervisory Patent Examiner, Art Unit 2617